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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/403,443

12/13/2000

Daniel Peter

6599 DEB

7279

25763

7590

07/28/2004

DORSEY & WHITNEY LLP  
INTELLECTUAL PROPERTY DEPARTMENT  
50 SOUTH SIXTH STREET  
MINNEAPOLIS, MN 55402-1498

EXAMINER

MAIORINO, ROZ

ART UNIT

PAPER NUMBER

3763

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/403,443

Applicant(s)

PETER ET AL.

Examiner

Roz Maiorino

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3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 22 and 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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***Election/Restrictions***

1. Newly submitted claims 21-23 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the newly submitted claims read on a different species than the originally presented claims, hence they will not be examined.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 21-23 withdrawn from consideration as being directed to a non-elected invention, Therefore this election is made **FINAL**. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S Patent No.5514097 to Knauer.

Knauer teaches a housing, a piston, a container and a propelling device. A base element, a first shifting stage, being shift-able relative to the base element, the first shifting stage on shifting, advances the piston in said container resulting in the liquid medicament being dispensed from the container in a metered manner,

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and at a second shifting stage, begin shift-able relative to the base element. The first and second shifting stages when seen in the advance direction of the piston overlap in part. The propelling device and the container are fixed in place in the housing, the piston is held in the container and the first shifting stage is connected to the piston only by exerting contract pressure on the piston. A male thread and a female thread forming a spindle drive connect the first and second shifting stages. Second shifting stage shifts and is movably slaved by a driven member of a second spindle drive. The first shifting stage and a shifting axis of the second shifting stage are parallel to each other. The second spindle drive is via a spur gear unit. The first shifting stage is prevented from rotating relative to the base element by an anti-rotating lock, the lock is formed by a slipper 630 having at least one sliding surface area relative to the base element and at least one sliding surface are relative to the first shifting stage. The slipper is jointly shifted together with the second shifting stage. The lock further comprises a sleeve body.

### ***Response to Arguments***

3. Applicant's arguments filed 5/25/2004 have been fully considered but they are not persuasive.

a. Applicants is alleging Knauer does not read on the limitation "first shifting stage is connected to said pistons only by exerting contact pressure on said pistons". Applicant further points to a push rod locking mechanism 626 in Knauer and alleges that teaches away from the above limitation. However the applicant has claims a first shifting stage (10) to be

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connected to the piston (K) only by exerting pressure. And as demonstrated by Knauer in Figure 5A the first shifting stage 317 is connected to the piston 524 only by exerting pressure. The push rod locking mechanism is NOT related to the connection between the pistons and the first shifting stage. It is not clear to the examiner how the applicant is interpreting the limitation "first shifting stage is connected to said pistons only by exerting contact pressure on said pistons" that would read on the push rod locking mechanism 626, such a mechanism not the connection between the piston 524 and the first shifting rod 317. Furthermore because the piston and the first-shifting rod are not connected mechanically they are capable of being exchanged separately.

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 703-305-2336. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
RM

  
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